

REMARKS

Upon entry of this amendment, claims 1-3, 7-13, 16-20, 22, 23, and 25-30 will be pending. Claims 4, 14, and 24 are currently cancelled without prejudice or disclaimer. Claim 1 (and claims 11 and 18) is amended by adding portions of claim 4 (and claims 14 and 24, respectively). Claims 16 and 22 are amended without change of scope. Claims 25-30 are newly added. The newly added claims contain no new matter and are supported by the specification at, for example, paragraph 37 (bottom page 10 of the specification as filed) and Figs. 1 and 2, reference 25.

The Office Action rejected claims 16 and 22 under 35 U.S.C. § 112, second paragraph. In response, the Applicants have amended claim 16 to properly depend from claim 11. As to the contended lack of clarity in claims 11 and 16, it is submitted that these claims already clearly and definitely recited that a user can specify to said input system the pre-determined location of the pre-printed unique identifier on a writing medium. Thereby, the input system is freed from having to make this determination itself. Nevertheless, these claims have been amended to make even more clear and definite what was already clear and definite.

The Office Action rejected pending claims 1-4, 7-14, 16-20, and 22-24 under 35 U.S.C. § 103(a) as unpatentable over US patent no. 5,838,819 to Ruedisueli et al. ("Ruedisueli") and US patent no. 5,629,499 to Flickinger et al. ("Flickinger")

Applicants traverse these rejections, first, because the combination of Ruedisueli and Flickinger does not teach each and every element of independent claims 1, 11, and 18 as arranged in these claims. For example, this combination does not disclose that a pre-printed unique identifier is "indicated to said input system by tracing over said pre-printed unique identifier".

It has already been established on the prosecution record that Ruedisueli does not disclose a writing medium with one or more sheets having pre-printed unique identifiers. Necessarily, then, Ruedisueli cannot disclose indicating pre-printed unique identifiers by tracing. Although Flickinger discloses forms with a few types of pre-printed identifiers (Fig. 5), none of these identifiers types are for tracing by a user. One such identifier type may be a form number (Fig. 5, reference 202).

However, this number is not traced, instead it is compared to form numbers displayed on an LCD (col. 3, lines 43-59). Another identifier may be a bar code (Fig. 5, reference 204), which is of course scanned by a bar-code reader and not traced by a user (col. 3, lines 65 to col. 4, line 2). A last identifier type taught by Flickinger is a small check box in a unique location. When the user checks the box, Flickinger's writing board identifies the location of the check box and thereby identifies the form (col. 4, lines 30-34). Thus, the Ruedisueli-Flickinger combination does not disclose tracing an identifier pre-printed on a writing medium.

A previously-identified benefit of such pre-printed unique identifiers are that they constrain the space of possible identifiers so that identification can be more accurate. Tracing of pre-printed identifiers further enhances such system accuracy, because, since traceable identifiers must be of a traceable size, the input system need not resolve unnecessarily fine detail. Further advantages of tracing pre-printed identifiers are that the input system does not need specialized components, such as bar-code readers, to read identifiers. Therefore, independent claims 1, 11, and 18 are patentable and advantageous over the combination of Ruedisueli and Flickinger.

Pending dependent claims 2, 3, 7-10, 12, 13, 16, 17, 19, 20, 22, 23, and 25-30 are also patentable over this combination because they inherit the patentable subject matter of their parent independent claims.

In addition, Applicants also submit that dependent claims 25-30 are independently patentable, because the combination of Ruedisueli and Flickinger does not teach their each and every element as arranged. For example, this reference combination does not disclose "indicating on which sheet of said writing medium the user is writing" by a "user control" comprising a "slider bar" manipulated by "touching".

Ruedisueli does not so disclose, at least because Ruedisueli's electronic notepad does not have any separate user controls at all. This notepad (10 in Fig. 10) includes only a paper clip (32 in Fig. 10), a sheet of paper (30 in Fig. 10), a writing/digitizer surface (26 in Fig. 10), and data ports (94 and 96 in Fig. 10). Further, changing writing sheets can only be indicated by entering new identifiers (col. 5, lines 26-32; and col. 7, lines 53-58). Flickinger's writing board also has no such control or control function. This board can sense only that a form has been changed, but cannot select a

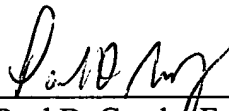
particular one out of a group of several sheets or forms. The presence of a new sheet or form is indicated either by entering a new identifier, by the methods already described or by physical means, such as by sensing paper clip motion or by detecting the sound of tearing a form from a form book (col. 3, lines 23-42; and col. 4, lines 19-30).

In contrast, the user controls recited in claims 25-30 provide economically-implemented, simple, convenient, and intuitive user page selection, and as such enhance the present invention in comparison to Ruedisueli and Flickinger. To select an already entered page, Ruedisueli's notepad requires accurate re-entry of page identifiers, followed by compute-intensive identifier comparison. Flickinger's writing board simply does not provide for entering and reviewing data on multiple paper sheets or multi-part forms. However, the present invention can select already entered pages by, for example, simply touching its user control. Therefore, dependent claims 25-30 are independently patentable and further advantageous over the combination of Ruedisueli and Flickinger.

In view of the foregoing, Applicants respectfully submit that all the Examiners objections and rejections have been addressed and that all of the claims in the present application are allowable. Accordingly, Applicants respectfully request that the claims be reconsidered and passed to allowance.

Respectfully submitted,

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